

REMARKS

The present application includes pending claims 1-7 and 9-23, all of which have been rejected. As an initial matter, the Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance **with every statutory requirement for patentability in the *initial review* of the application**, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel ***should state all reasons and bases for rejecting claims in the first Office action.*** Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. **Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved.** A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

Manual of Patent Examining Procedure (MPEP) § 2106(II) (emphasis added). As such, the Applicants assume, based on the goals of patent examination noted above, that *this* Office Action has set forth “all reasons and bases” for rejecting the claims.

Further, this Response does not amend any of the claims. Therefore, the Applicants respectfully submit that this Response cannot raise any new issues with respect to the pending claims that would require a further search. In short, a never-ending process of repeatedly dredging up different prior art references after the Applicants effectively render rejections moot without amending the claims unquestionably undermines the principles of compact prosecution.

Additionally, the present application has been pending since **April 2, 2004**, and has undergone extensive prosecution. Therefore, the Applicants respectfully request that the present application be allowed, for at least the following reasons.

I. Claim 23 Is Definite

Claim 23 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

In particular, the Office Action states the following:

In claim 23, applicants claim “a radio frequency communication system **comprising**: transmitter circuitry...; switch circuitry; receiver circuitry...; the radio frequency communication system...” “The radio frequency communication system” is not part of “a radio frequency communication system”, which makes the apparatus indefinite.

See November 17, 2008 Office Action at page 3 (emphasis in original).

Claim 23 recites, however, the following:

A radio frequency communication system comprising:

transmitter circuitry configured to be arranged in first and second configurations, wherein the first configuration is different than the second configuration;

switching circuitry; **and**

receiver circuitry for accepting a radio frequency signal from the switching circuitry, the receiver circuitry producing at least a receive signal strength indicator;

the radio frequency communication system adjusting at least one characteristic of the receive signal strength indicator based on two signal power measurements using the switching circuitry and the transmitter circuitry.

Thus, the claim is clear that the radio frequency communication system comprises (1) transmitter circuitry, (2) switching circuitry **and** (3) receiver circuitry. “The radio frequency communication system” recited in the claim is not an additional component of the system. Rather, it **is** the system. Hence, the clause recites “**the**” radio frequency communication system. Thus, the Applicants respectfully request reconsideration of the rejection of claim 23 as being indefinite.

II. Rejections Under 35 U.S.C. § 103

Claims 1, 3-4 and 10-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 2004/0064281 (“Kim ‘281”). Claims 2 and 6-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim ‘281 in view of U.S. 6,603,810 (“Bednekoff”). Claims 5 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim ‘281 in view of U.S. 6,704,352 (“Johnson”). Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim ‘281 in view of U.S. 6,801,788 (“Csapo”). Claims 15-18 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 2005/0095993 (“Kim ‘993”). Claims 15-18 and 22 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim ‘993 in view of Kim ‘281. Claims 15 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 2004/0063412 (“Kim ‘412”). Claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kim ‘412 in view of U.S. 6,704,352 (“Johnson”). Claims 20-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kim ‘412 in view of Bednekoff. The Applicants respectfully traverse these rejections for at least the following reasons:

A. The § 103 Rejections Based On Kim ‘281

The Applicants first turn to the rejection of claims 1, 3-4 and 10-13 under 35 U.S.C. § 103(a) as being unpatentable over Kim ‘281. The present application was filed April 2, 2004 and claims priority to a provisional application filed on November 26, 2003. The present application is assigned to Broadcom Corporation. *See* USPTO Reel/Frame 014858/0614.

Kim ‘281 was published on April 1, 2004, after the November 26, 2003 priority date of the present application. Thus, Kim ‘281 does not qualify as prior art under 35 U.S.C. § 102(a) or (b) with respect to the present application. Moreover, Kim ‘281 is also assigned to Broadcom

Corporation. *See* USPTO Reel/Frame 013334/0731.

35 U.S.C. § 103(c)(1) states the following:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

As noted above, both the present application and Kim '281 are assigned to Broadcom Corporation. Kim '281 and the present application were, at the time the inventions disclosed in the present application were made, owned by the same entity, *i.e.*, Broadcom Corporation, or subject to an obligation of assignment to that entity. As such, Kim '281 is disqualified as prior art under 35 U.S.C. § 103(a) against the claims of the present application. For at least this reason, Kim '281 cannot render claims 1, 3-4 and 10-13 unpatentable under 35 U.S.C. § 103(a).

Similarly, Kim '281, alone or in combination with any of Bednekoff, Johnson and/or Csapo cannot render claims 2, 5-7, 9 and 14 unpatentable under 35 U.S.C. § 103(a).

B. The § 103 Rejections Based On Kim '993

The Applicants next turn to the rejection of claims 15-18 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Kim '993. As noted above, the present application was filed April 2, 2004 and claims priority to a provisional application filed on November 26, 2003. The present application is assigned to Broadcom Corporation. *See* USPTO Reel/Frame 014858/0614.

Kim '993 was published May 5, 2005, more than one year after the filing date of the present application. Thus, Kim '993 does not qualify as prior art under 35 U.S.C. § 102(a) or (b) with respect to the present application. Moreover, Kim '993 is also assigned to Broadcom Corporation. *See* USPTO Reel/Frame 014679/0138.

Kim '993 and the present application were, at the time the inventions disclosed in the present application were made, owned by the same entity, *i.e.*, Broadcom Corporation, or subject to an obligation of assignment to that entity. As such, Kim '993 is disqualified as prior art under 35 U.S.C. § 103(a) against the claims of the present application. For at least this reason, Kim '993 cannot render claims 15-18 and 22 unpatentable under 35 U.S.C. § 103(a).

Similarly, Kim '993 alone or in combination with Kim '281 cannot render claims 15-18 and 22 unpatentable under 35 U.S.C. § 103(a) for at least the reasons discussed above.

C. The § 103 Rejections Based On Kim '412

The Applicants now turn to the rejection of claims 15 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Kim '412. As noted above, the present application was filed April 2, 2004 and claims priority to a provisional application filed on November 26, 2003. The present application is assigned to Broadcom Corporation. *See* USPTO Reel/Frame 014858/0614.

Kim '412 was published April 1, 2004, which is later than the November 26, 2003 priority date for the present application. Thus, Kim '412 does not qualify as prior art under 35 U.S.C. § 102(a) or (b) with respect to the present application. Moreover, Kim '412 is also assigned to Broadcom Corporation. *See* USPTO Reel/Frame 013336/0292.

Kim '412 and the present application were, at the time the inventions disclosed in the present application were made, owned by the same entity, *i.e.*, Broadcom Corporation, or subject to an obligation of assignment to that entity. As such, Kim '412 is disqualified as prior art under 35 U.S.C. § 103(a) against the claims of the present application. For at least this reason, Kim '412 cannot render claims 15 and 23 unpatentable under 35 U.S.C. § 103(a).

Similarly, Kim '412, alone or in combination with either of Johnson and/or Bednekoff, cannot not render claims 19-21 unpatentable under 35 U.S.C. § 103.

III. Conclusion

As explained above, all of the claim rejections are now rendered moot. The Applicants note that the present application has been pending since April 2, 2004, and has undergone extensive prosecution. Therefore, the present application should now be allowed with dispatch.

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim).

The Applicants respectfully request that the outstanding rejections be reconsidered and withdrawn for at least the reasons discussed above. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the Applicants.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

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MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100

Respectfully submitted,

/Joseph M. Butscher/
Joseph M. Butscher
Registration No. 48,326
Attorney for Applicants